

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte

ROBERT L. POPP, MICHAEL T. MORMAN, PAUL VANGOMPEL,
PAUL M. LINKER, and DEBRA DURRANCE

Appeal 2008-0182
Application 10/038,818
Technology Center 3700

Decided: July 22, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing (reconsideration) of the decision entered January 25, 2008. That decision affirmed the Examiner's rejection of claims 19 and 25 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

Appellants' request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the Examiner's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

DISCUSSION

Appellants argue that the previous decision “misapprehended that the material labeled ‘Sample A’ in Table II of Hetzler has a machine direction elongation of 263% in its final form (i.e., as used in the diaper)” (Req. Recons. 1). Appellants contend that “Sample A was elongated 263% during an intermediate step of its manufacture. . . . There is no teaching or suggestion by Hetzler, however, that the sample is capable of such elongation after it has been annealed, which is the final form of the material” (*id.*).

We have reviewed our Decision in light of the arguments presented by Appellants in the Request. However, we are not persuaded that our Decision was in error. Hetzler discloses two different columns in Table II, one with the subheading “PROCESS TEMPERATURES” and the other with a subheading “Tensile Testing” (*see* Hetzler, col. 15, ll. 20-30). Hetzler discusses that the “laminates were preheated, stretched and annealed at the temperatures shown in Table II (and, for Example 2, Table IV) below” (Hetzler, col. 13, ll. 51-53). Appellants argue that this statement not only teaches the “PROCESS TEMPERATURES” but also teaches the conditions under which Hetzler performed the “Tensile Testing” and that the “263% machine direction elongation of Sample A was measured while the material was being heated to 195°F and before it was annealed at 230°F” (Req. Recons. 3).

In our opinion, Appellants are in error since Hetzler specifically discusses the conditions for the “Tensile Test” at column 14, lines 34-44, and this test represents an entirely different test than the “Stretching of Laminates” test disclosed at column 13, lines 48-54. Hetzler teaches that the “transverse strain peak of the laminates (measured in grams) and elongation at peak load (measured in %)) were determined in accordance with Method 5102 Federal Test Methods Standard Number 191A” (Hetzler, col. 14, ll. 34-37). There is no indication in Hetzler that the “Tensile Test” has anything to do with the subheading “STRETCHING OF LAMINATES”. The text of Hetzler supports the conclusion that the “Tensile Test” is a different measure than the “STRETCHING OF LAMINATES” since these processes are described at different locations, under different subheadings and discuss different procedures (*see* Hetzler, col. 13-14).

Additionally, even if Hetzler was performing the “Tensile Test” upon an intermediate, Appellants do not dispute that the combination taught by Hetzler meets the structural limitations of the claims. Appellants are only disputing whether the final laminated product of Hetzler retains the property of having machine direction elongation of 263%.

The Examiner’s position that the final mechanical fastening product of Hetzler would be capable of being stretched 2.0 times has specific basis in the disclosure of Hetzler that at least an intermediate, if not the final product, has this property (*see* Hetzler, table II). Therefore, the Examiner established a *prima facie* case of unpatentability at least based on inherency, thereby shifting to Appellants the burden of proving that Hetzler’s product was not capable of being stretched 2.0 times as required by claim 19. *See In re Best*,

562 F.2d 1252, 1255 (CCPA 1977)(“Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products”). On this record, Appellants have proffered no such proof. The Examiner's Final Office action served to place Appellants on notice that they needed “to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *Best*, 562 F.2d at 1255. Appellants did not meet this burden of production.

SUMMARY

We have carefully reviewed the original opinion in light of Appellants' request, but we find no point of law or fact which we overlooked or misapprehended in arriving at our decision. To the extent relevant, Appellants' request amounts to a reargument of points already considered by the board.

Therefore, Appellants' request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the Examiner's rejection under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

DENIED

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cdc

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